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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/064,235	06/24/2002	H. Randall Craig	HRCM.P-004	6384

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EXAMINER

ROBERTS, PAUL A

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 03/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/064,235

Applicant(s)

CRAIG, H. RANDALL

Examiner

Paul A Roberts

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 9/26/02.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 September 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-15, drawn to an apparatus, classified in class 606, subclass 1.
- II. Claim 16, drawn to method of suturing, classified in class 606, subclass 144. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, invention I as claimed can be used for cooking, holding utensils, removing corks, or drilling holes.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

This application contains claims directed to the following patentably distinct species of the claimed invention: Applicant has disclosed multiple species of spatula elements 40-44.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1 and 11 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention. During a telephone conversation with Carl Oppedahl on February 25, 2004 a provisional election was made with traverse to prosecute the invention of Group I species 41, claims 1-15. Affirmation of this election must be made by applicant in replying to this Office action. Claim 16 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this

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subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1, 3, 5, 6, 9, and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Lewis 2001/0045753. Lewis discloses an apparatus having a first end and a second end, the first end comprising a spatulate member (3) having a length along a first axis; the second end (4) comprising a guide shaped to receive a cylindrical axle for rotation on a second axis, the guide shaped to constrain the first axis in fixed position relative to the second axis, the first and second axes each lying within a plane (XZ plane); the spatulate member extending in a first direction and a second direction from the first axis (+ and – in the Y direction), the first direction and second direction being on opposite sides of the plane.
2. Regarding claim 2, the first and second axes are more than one-quarter inch apart and less than an inch apart.
3. Regarding claim 3, wherein the length of the spatulate member is greater than one inch and less than seven inches.
4. Regarding claim 5, the extensions in the first and second directions define a width, the width being less than one-third of the length.
5. Regarding claim 6, wherein the spatulate member is symmetric relative to the first axis.
6. Regarding claims 9 and 10, the apparatus is made of plastic or of metal.
7. Claims 1, 4, 6, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Fitch et al. (Fitch) US 3,063,360. Fitch discloses an apparatus having a first end and a second end, the first end comprising a spatulate member (the base 9) having a length along a first axis; the second end comprising a guide (10) shaped to receive a cylindrical axle for rotation on a second axis, the guide shaped to constrain the first axis in fixed position relative to the second axis, the

first and second axes each lying within a plane (XZ plane); the spatulate member extending in a first direction and a second direction from the first axis (+ and – in the Y direction), the first direction and second direction being on opposite sides of the plane.

8. Regarding claim 4, the guide comprises two members each extending toward the second axis from the first axis, each of the two members having a hole shaped to receive the cylindrical axle.

9. Regarding claim 6, wherein the spatulate member is symmetric relative to the first axis.

10. Regarding claim 10, the apparatus is made of metal.

11. Claims 11-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Goldzweig 4874156. Regarding claims 11 and 12, Goldzweig discloses a system comprising a helical suture instrument (Goldzweig discloses an instrument capable of use with suturing. For example, one can place a patient's arm in the vice to hold it still while the surgeon sutures a wound together. The instrument is helical because it contains helical section 41.) The apparatus having a first end and a second end, the first end comprising a spatulate member (42 and 83) having a first length along a first axis; the helical suture instrument having a cylindrical axle (41) defining a second axis and a helical portion (the threads on bolt 41 are helical), the helical portion having a helical outer diameter and having a second axial length along the second axis (the second axis is collinear with element 41), the second end of the apparatus comprising a guide (65) shaped to receive the cylindrical axle for rotation on the second axis, the guide shaped to constrain the first axis in fixed position relative to the second axis, the first and second axes each lying within a plane; the spatulate member extending in a first direction and a second direction from the first axis, the first direction and second direction being on opposite sides of the plane; wherein the

first and second axes are farther apart than the helical outer diameter, whereby there is space between the helical portion and the apparatus; wherein the first length is at least five-sixths of the second length. (The spatula member is longer than the helical member.)

12. Regarding claim 13, the guide (65) comprises two members (each face 67 and 68 are considered a member) each extending toward the second axis from the first axis, each of the two members having a hole (each face has a hole) shaped to receive the cylindrical axle.

13. Regarding claim 14, the extensions in the first and second directions define a width (space between 67 and 68), the width being less than one-third of the first length.

14. Regarding claim 15, the spatulate member is symmetric relative to the first axis.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lewis '753. Lewis discloses all of claim 1, but does not disclose making the device sterile and does not disclose wrapping the device in plastic. Since the Lewis device is designed to be used with culinary tasks manufacturing the device and selling it as a sterile unit would be advantageous because the customer would not be at initial risk of bacteria contaminating the cook's food. At the time of the invention it would have been obvious to one having ordinary skill in the art to sterilize the Lewis device to remove any bacteria from the device to prevent bacteria from

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contaminating the food the device is designed to cook. One known means of maintaining sterility of product until it reaches its intended consumer is to wrap the device in a plastic wrapper. At the time of the invention it would have been obvious to one having ordinary skill in the art to wrap the Lewis device in plastic immediately after sterilizing it, in order to maintain sterility of the instrument.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Surgical Ligator US 5797928

Barbeque rotisserie machine US 4817514

Helical orthopedic fixator US 6663633

Suturing device US 6086601

Rotating Rack US 2634674

Meat cooking sauce pot US 102348


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A Roberts whose telephone number is (703) 305-7558. The examiner can normally be reached on 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J Milano can be reached on 703-308-2496. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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03/01/04



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